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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,777	06/27/2003	Benjamin Gross	2190.002USU	8125

7590 08/17/2005

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EXAMINER
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BOTTS, MICHAEL K

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/608,777

Applicant(s)

GROSS ET AL.

Examiner

Michael K. Botts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 2 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This document is the first Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on June 27, 2003.
2. Claims 1-20 have been examined, with claims 1, 10, and 20 being the independent claims.
3. Claims 2 and 9 are objected to.
4. Claims 1-20 are rejected.

### ***Claims Objections***

5. **Dependent claim 2** is objected to as being an improper Markush claim, reciting: "The system of claim 1, wherein said creative content is obtained from the group consisting of a text file, a graphics file, a video file, a web page, and audio file, a user, and any combinations thereof." The members of a Markush group must possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it must be clear from their very nature or from the prior art that all of them possess this property. See, MPEP 2173.05(h)(I).

In claim 2, the property of the Markush members is their function within the method of claim 1, specifically, a representation of a creative content with the ability to be disposed on an adhesive label that may then be affixed to a page in a book. See, claim 2 as depended from claim 1. Creative content obtained from a video or audio file cannot be disposed on a label, without being first translated to a text or graphics file.

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Text and graphics files are already identified within the Markush elements. Similarly, any creative content obtained from a web page that is capable of disposed on a label is already in the form of a text or graphics file. Therefore, the elements for the Markush claim are reduced to "a text file, a graphics file, a user, and any combination thereof."

Appropriate correction is required.

6. **Claim 9** is objected to because of the following informalities: The claim appears to be followed by an incomplete text which appears on page 14, lines 1-2, stating: "comprises a board book having a plurality of pages of a rigid an durable pressed paper." In that claim 9, as it appears on page 13, ends in a period and appears to be complete, the additional language appearing on page 14 is considered to have been left in error and it will not examined. Appropriate correction is required.

***Claims Rejection, 35 U.S.C. 112, First Paragraph***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Dependent claim 18** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 18 states: "The system of claim 10, further comprising an audio

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input device and an audio output device for the recording and playback of audio, respectively.” Claim 18 purports to be a further limitation of claim 10. Claim 10 limits that any creative content to be affixed to a page in a book must be disposed to an adhesive label. The specifications do not enable the disposition of audio content to a printable label.

**Dependent claim 18** is further rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure that is not enabling. A method or means to dispose audio information onto a printable sticker or label is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Nothing in the disclosure identifies placing audio content onto a printed label and nothing in the disclosure claims that this was known or practiced by one of ordinary skill in the art at the time of the invention.

***Claims Rejection, 35 U.S.C. 112, Second Paragraph***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 1-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant claims a method and two systems for “publishing” a book. It is unclear whether the terms “publish,” “publishing,” and “published” are intended to limit the claims under the ordinary definition of the term, or,

alternatively, whether they mean to “create.” To one of ordinary skill in the art, the accepted definition of the term publish is: “to prepare and issue (printed material) for public distribution or sale.” See, “publish” as defined in The American College Dictionary, Fourth Ed., 2002. However, there is nothing in the application to indicate that the book produced by this invention is intended for public distribution or sale. See, page 9, line 19 through page 10 Fig. 4.

The disclosure makes a passing reference to equate the term “create” and “publish” while stating the problem in the art: “Known publishing products and systems do not fully meet the creative needs of a user seeking to create (i.e., publish) works having completely personalized and variable content.” See, page 1, lines 10-13. In addition, the lack of clarity of the term “publish,” as used in the application, causes the last step or the end product of the method and systems to be unclear. It is not known whether the last step is the creation of the book by affixing labels, or whether it is the “publication” of the book.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “publish” in claims 1-20 is used by the claims to mean “create,” while the accepted meaning is “prepare and issue for public distribution or sale.” The term is indefinite because the specification does not clearly redefine the term. It is

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suggested that the applicant substitute the term “create” for the term “publish.”

11. **Claims 1-20** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Independent claims 1, 10, and 20 omit the essential step and dependent claims 2-9 and 11-19 inherit the omission due to their dependency on claims 1 and 10, respectively. The omitted step is the “publishing” step. The preamble to claim 1 recites: “A method of publishing a book . . . .” The preamble of claims 10 and 20 both claim: “A system for publishing a book . . . .” Claims 1, 10, or 20 fail to disclose a step that would constitute “publication.”

As quoted above from the dictionary, the element of “publication” necessarily implies “prepare and issue for public distribution or sale.” Also as noted above, the applicant may have intended to claim the “creation” or “production” of a book, rather than its “publication.”

12. **Independent claims 1, 10, and 20** are rejected as containing a term contrary to its ordinary meaning. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). See, MPEP 2106 and 2111.1.



The term "page" in claim 1 is used in the phrase "a page comprising said book." See, claim 1, line 13. The term "page" in claims 10 and 20 is used in the phrase "a book being a page." See, claim 10, line 13, and claim 20 line 13. Use of the term "page" as cited above states that a single page may be a book. This is contrary to the accepted meaning of a book as being: "a *set of pages* fastened along one side and encased between protective covers." See, "book" as defined in The American College Dictionary, Fourth Ed., 2002. Note also the definition of "book" in the patent classification system, as follows:

A book consists of *two or more sheets*(\*) secured together either: (a) only at their margins; or (b) only at a restricted field within the margins; or (c) only at their margins and at a restricted field within the margins. When a margin of one sheet is attached to a margin of another sheet(\*) to obtain in effect a single sheet(\*) or greater area, the resulting article is still regarded as a sheet(\*) rather than a book. A folded sheet is not considered to be a book. Book and bound book are synonymous terms and in both, a covering member has not yet been applied.

U.S. Patent Class 412, Bookbinding: Process and Apparatus, Glossary definition of "book." As the term was used by one skilled in the art at the time of the invention, a "book" contains more than one page. It is believed that the applicant intended "book" to be used in the standard sense in that the disclosure is consistent with the accepted definition of a book containing multiple pages. See, page 10, lines 5-11: "The bookmaker may start with a . . . multiple paged bound board book . . .".

It is suggested that the term in claim 2 be amended to read: "... a page within said book ..." or "... at least one of the pages of said book ..." or another phrase that accurately reflects that the page to which the label is being affixed is



one of a plurality of pages within a book.

***Claims Rejection, 35 U.S.C. § 101***

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Specifically:

**Independent claim 1** reads on merely drawing a face on a sticky note (disposing creative content), placing it in a book, such as to be used to mark a page (affixing the label to a book), and then later donating the book to a library or selling it at a yard sale (publication).

**Dependent claim 2** is fully met by the same facts of claim 1, above, since the user drew the face on the sticky note (creative content obtained from user).

**Dependent claim 3** is fully met by the additional manual step of placing a strip of clear cellophane tape over the sticky note, such as to securely affix it in the book (disposing a clear protective coating).

**Dependent claim 4**, which is depended from claim 3, is fully met by the fact

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example of claim 3, above, since cellophane tape would “matingly conform” to the sticky note.

**Dependent claim 5** is fully met by the same facts of claim 1, since the user “customized” the label with his or her “preference” in where and how the face was drawn on the sticky note.

**Dependent claim 6** reads on the fact example of claim 1, above, wherein what is drawn on the sticky note was copied from what appeared on a computer screen. copying by drawing what appears on a picture on a computer screen is customizing “using a software module compatible with said creative content,” when the creative content comes from the “user,” as is permitted under claim 1.

**Dependent claim 7** is fully met by the book described in the fact example of claim 1, above, which has two sticky notes, with something drawn on them, attached to any two pages (a plurality of labels on a plurality of pages). Two sticky note bookmarks with notations on them are sufficient to meet the limits of this claim.

**Dependent claim 8** is fully met by the fact example of claim 1, above, wherein the book is a common children’s book (a book with rigid and durable pressed paper pages).

**Dependent claim 9** reads initially on a “story,” which was known in the art at the time of the invention as “an account or recital of an event or series of events, either true or fictitious.” See, “story” as defined in The American College Dictionary, Fourth Ed., 2002. Any picture drawn by the user, particularly a cartoon such as a political cartoon, can obviously convey a story. Such cartoon would necessarily be “fully personalized

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and completely customized.” Claim 9 is fully met by rendering a cartoon onto a sticky note and placing it into a book, which book is then offered for sale at a yard sale.

The applicant may obviate the 35 U.S.C. 101 objections by amending the preamble to independent claim 1 to read “a *computerized* method of . . .” and by accordingly amending the claims depending from claim 1 to further limitations of the computerized method.

### ***Claims Rejection, 35 U.S.C. § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 1, 2, 5-12, 15-17, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rifkin (U.S. Patent 6,116,906, filed in 1998 [hereinafter “Rifkin”]), in view of Engel (U.S. Patent 4,714,275, filed in 1986 [hereinafter “Engel”]), wherein Rifkin recites that it was well known in the art at the time of the Rifkin invention of printing user selected designs onto adhesive paper to be used like conventional stickers, and Engel recites that the it was well known in the art at the time of the Engel invention to mount stickers in albums. Both Rifkin and Engel predate the earliest effective filing date of the present application.

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Regarding **Independent claim 1**, Rifkin in view of Engel teaches:

A method of publishing a book, said method comprising:

- obtaining creative content for inclusion in said book;

(See, Rifkin, col. 1, lines 19-22: *"Desktop publishing may be obtained from a number of software providers which is used by the computer to create images at the user's selection upon the display monitor which are then passed to the printer for a hard copy of the selected design."*)

- disposing at least a portion of a representation of said creative content on an adhesive label, a substance, a layout, and an extent of said at least a portion of said creative content disposed on said adhesive label being fully customizable;

(See, Rifkin, col. 1, lines 33-42: *"While originally such [computer and printer] systems were used entirely to print images upon paper, in recent years it has been found equally advantageous to print images upon a peel-off sticker bearing media. Thus, sheets of paper shaped in accordance with standard sheet sizes are supported adhesively upon an impervious carrier similar to conventional peel-off stickers. As these sticker sheets are passed through the printer, selected images are placed upon the stickers at the appropriate location by the desktop publishing software."*)

- affixing said adhesive label having at least a portion of said representation of said creative content disposed thereon to at least a portion of a page comprising said book, wherein said obtaining, said disposing, and said affixing are performed under the direct control of a user.

(See, Engel, col. 1, lines 16-17: *"A popular hobby with children is collecting theme*

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*stickers and mounting them in an album.”)*

Rifkin teaches that it was known in the art to use of a computer and computer program for the selection of matter to be printed onto an adhesive label page and the use of a printer to produce such labels. Specifically, Rifkin teaches creating customizable stickers on a computer and printing them out and affixing the resulting label or sticker to a toy. Rifkin does not disclose that it was well known to place such stickers in a book.

Engel teaches that affixing stickers to books was well known by those of ordinary skill in the art at the time of the invention. Engel does not specifically teach obtaining creative content for those stickers from a computer and disposing that creative content onto stickers using the computer's printer.

In combination, the teachings of Engel and Rifkin would result in selection of creative material from a computer using software to manipulate such images, disposing that material to an adhesive label using a computer and attached printer, printing out the label, and affixing the label or sticker to a page of a book.

One of ordinary skill in the art at the time of the invention facing the problem of creating stickers with a computer in order to place those stickers in a book would be motivated to combine Engel and Rifkin. Both Engel and Rifkin are related patents dealing with uses of adhesive labels relating to children and children's games and it would be obvious to one of ordinary skill in the art to combine the teachings Rifkin to use a computer to print out stickers with the teachings of Engel recognizing that it was old in the art to place stickers in a book. The resultant combination would be the

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selection of content from a program on the computer, creation of one or more stickers on the computer, printing out the stickers onto adhesive backed paper sheets, and placing the resultant stickers on one or more pages in a book.

Regarding **dependent claim 2**, Rifkin in view of Engel teaches:

The method of claim 1, wherein said creative content is obtained from the group consisting of a text file, a graphics file, a video file, a web page, an audio file, a user, and any combinations thereof.

(A child collecting stickers and affixing them to the album would be the user. See, Engel, col. 1, lines 16-17.)

Regarding **dependent claim 5**, Rifkin in view of Engel teaches:

The method of claim 1, further comprising customizing at least said substance, said layout, and said extent of said at least a portion of said creative content disposed on said adhesive label, according to a user's preference.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 1 above. It is noted that claim 1 reads on preparation of such a label for affixing to a page in a book includes a label or sticker that is drawn or colored upon by the user. By common sense, such label is creative content that is customized as to substance, layout, and extent according to the user. Therefore, combining the teachings of Rifkin in view of Engel to obtain a sticker or label, draw or color upon it, and affix it to a page in a book were all well known by one of ordinary skill in the art at the time of the invention.

Regarding **dependent claim 6**, Rifkin in view of Engel teaches:

The method of claim 5, wherein said customizing is accomplished using a software module compatible with said creative content obtained for inclusion in said book.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 5 above.

Specifically, Rifkin recites that it was well known by one of ordinary skill in the art at the time of the invention to use computer software to create user customized content to be printed on stickers. See, Rifkin, col. 1, lines 19-24 and 33-36: "Desktop publishing software may be obtained from a number of software providers which is used by the computer to create images at the user's selection upon the display monitor which are then passed to the printer for a hard copy of the selected design. \* \* \* While originally such systems were used entirely to print images upon paper, in recent years it has been found equally advantageous to print images upon a peel-off sticker bearing media."

Regarding **dependent claim 7**, Rifkin in view of Engel teaches:

The method of claim 1, wherein said book has, in total, a plurality of said adhesive labels affixed to a plurality of said pages of said book.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 1 above. The additional limitation of affixing a plurality of adhesive labels onto a plurality of pages of a



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book is not disclosed in the specifications as being inventive. The decision to affix one or many stickers on one or many pages of a book would have been an obvious design consideration to one of ordinary skill in the art at the time the invention was made.

Regarding **dependent claim 8**, Rifkin in view of Engel teaches:

The method of claim 1, wherein said book comprises a board book having a plurality of pages of a rigid and durable pressed paper.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 1 above. Claim 8 adds to claim 1 the additional limitation that pages of the book be of "rigid and durable pressed paper." The additional limitation of the page thickness is not disclosed in the specifications as being inventive. The disclosure discusses a preference for a certain thickness of paper, not as a part of the invention, but rather as part of the workpiece and as an obvious design choice to accommodate rough usage by children. See, page 5, lines 2-4: "The pages of board book 100 may be about 14 millimeters (miles) thick. Other thicknesses of material may be used." The selection of any certain thickness of paper or "durable pressed paper" would have been an obvious design consideration to one of ordinary skill in the art at the time the invention was made. A change in size is generally recognized as not being sufficient to patentably distinguish over the prior art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The use of thicker paper in the book for the application of stickers is a mere design consideration.

Regarding **dependent claim 9**, Rifkin in view of Engel teaches:

The method of claim 1, wherein said book published thereby is a fully personalized and completely customized story.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 1 above. Claim 8 adds to claim 1 the additional limitation that the story be “fully personalized and completely customized.” Claim 1 states that the labels must be “customizable.” To actually customize the labels would be obvious to one of ordinary skill in the art at the time of the invention and is not, therefore, an inventive limitation.

Applicant has not disclosed that creating a story from customizable labels solves any stated problem or is for any particular purpose. Moreover, it is obvious that customizable labels could and would be customized and used to tell a story. Further, it is common sense that a story told with completely customized labels would be fully personalized. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the customizable labels to tell a completely customized and fully personalize story.

Regarding **Independent claim 10**, Rifkin in view of Engel teaches:

A system for publishing a book, said system comprising:

- an input device for obtaining creative content for inclusion in said book;

(See, Rifkin, Fig. 1, col. 4, lines 5-6 and 11-14: “In operation and in accordance with the present invention, a CD-ROM disk 17 is inserted into a drive input 18.” “In the preferred

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fabrication of the present invention gave, inputs to processor 11 are provided using keyboard 13 and/or mouse 14 to display a selected vehicle image 40 upon display screen 15.”)

- a processor for controlling the disposing of at least a portion of a representation of said creative content on an adhesive label, a substance, a layout, and an extent of said at least a portion of said creative content disposed on said adhesive label being fully customizable;

(See, Rifkin, Fig. 1, col. 4, lines 14-16: “Thereafter, inputs are provided to processor 11 which switch the display image upon display screen 15 to a display image 16.”)

- an output device for performing said disposing;

(See, Rifkin, Fig. 1, col. 4, lines 26-28: “In accordance with the software on CE-ROM 17, the print operation of printer 20 under control of processor 11 is formatted to correspond to the size and location of various ones of said blank stickers 23 through 26 on blank sheet 22.”)

- a book being a page for affixing said adhesive label with at least a portion of said representation of said creative content disposed thereon to at least a portion of said page, wherein said obtaining, said disposing, and said affixing are performed under the direct control of said user.

(See, Engel, col. 1, lines 16-17 and 20-22: “A popular hobby with children is collecting theme stickers and mounting them in an album.” \* \* \* “These stickers are mounted in albums which the child keeps and periodically examines.”)

See 35 U.S.C. 103(a) rejection of claim 1 above for the *Graham v. John Deere*

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factors supporting the combination of Rifkin and Engel.

Regarding **dependent claim 11**, Rifkin in view of Engel teaches:

The system of claim 10, wherein said input device obtains said creative content from the group consisting of a text file, a graphics file, a video file, a web page, an audio file, a user, and any combinations thereof.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above.

Further, see, Engel, col. 1, lines 16-17, and note that a child collecting stickers and affixing them to the album would be the user.

Regarding **dependent claim 12**, Rifkin in view of Engel teaches:

The system of claim 10, wherein said input device is selected from a group consisting of a mouse, a memory media reader, a memory storage device, a digital camera, a microphone, an optical scanner, and any combinations thereof.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 10 above. See, Rifkin, Fig. 1 and col. 4, lines 5-6 and 11-14: "In operation and in accordance with the present invention, a CD-ROM disk 17 is inserted into a drive input 18." "In the preferred fabrication of the present invention gave, inputs to processor 11 are provided using keyboard 13 and/or mouse 14 to display a selected vehicle image 40 upon display screen 15."

Regarding **dependent claim 15**, Rifkin in view of Engel teaches:

The system of claim 10, wherein said user customizes at least said substance, said layout, and said extent of said at least a portion of said creative content disposed on said adhesive label, according to at least one of said user's preferences.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. It is noted that claim 1 reads on preparation of such a label for affixing to a page in a book includes a label or sticker that is drawn or colored upon by the user. By common sense, such label is creative content that is customized as to substance, layout, and extent according to the user. Therefore, combining the teachings of Rifkin in view of Engel to obtain a sticker or label, draw or color upon it, and affix it to a page in a book were all well known by one of ordinary skill in the art at the time of the invention.

Regarding **dependent claim 16**, Rifkin in view of Engel teaches:

The system of claim 15, wherein said customizing is accomplished with the aid of a software module compatible with said creative content obtained for inclusion in said book.

The creation, disposition, and affixing of labels containing a user's preferences to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 15 above. See, Rifkin, col. 1, lines 19-23 reciting that the use of

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software to create and print was known in the art at the time of the Rifkin invention, stating: "Desktop publishing software may be obtained from a number of software providers which is used by the computer to create images at the user's selection upon the display monitor which are then passed to the printer for a hard copy of the selected design."

Regarding **dependent claim 17**, Rifkin in view of Engel teaches:

The system of claim 10, wherein said book published using said system has, in total, a plurality of said adhesive labels affixed to a plurality of said pages of said book.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. The additional limitation of affixing a plurality of adhesive labels onto a plurality of pages of a book is not disclosed in the specifications as being inventive. The decision to affix one or many stickers on one or many pages of a book would have been an obvious design consideration to one of ordinary skill in the art at the time the invention was made.

Regarding **dependent claim 19**, Rifkin in view of Engel teaches:

The system of claim 10, wherein said book comprises a board book having a plurality of pages of a rigid and durable pressed paper.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. Claim

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19 adds to claim 10 the additional limitation that pages of the book be of “rigid and durable pressed paper.” The additional limitation of the page thickness is not disclosed in the specifications as being inventive. The disclosure discusses a preference for a certain thickness of paper, not as a part of the invention, but rather as part of the workpiece and as an obvious design choice to accommodate rough usage by children. See, page 5, lines 2-4: “The pages of board book 100 may be about 14 millimeters (miles) thick. Other thicknesses of material may be used.” The selection of any certain thickness of paper or “durable pressed paper” would have been an obvious design consideration to one of ordinary skill in the art at the time the invention was made. A change in size is generally recognized as not being sufficient to patentably distinguish over the prior art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The use of thicker paper in the book for the application of stickers is a mere design consideration.

17. **Claims 3, 4, 13, and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rifkin in view of Engel as applied by claims 3 and 4 to claim 1 and as applied by claims 13 and 14 to claim 10 above, and in further in view of “Reproducible Mini Books for Emergent Readers,” by Smith, Victoria, copyrighted 1998 & 1999 [hereinafter “Smith”].

Regarding **dependent claim 3**, Rifkin in view of Engel in further view of Smith teaches:

The method of claim 1, further comprising disposing a clear protective covering over said adhesive label affixed to at least a portion of said page, wherein said at



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least a portion of said creative content disposed on said label is visible through said protective covering.

(See, Smith, page 1: "Enlarge the pictures and text, color them, glue them to construction paper, and laminate them to make a Big Book for Shared Reading . . .")

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. Although Smith does teach using adhesive stickers to affix the pictures to the book pages prior to lamination, it would have been obvious to one of ordinary skill in the art at the time of the invention to enlarge the pictures by photocopying or computer printing onto widely commercially available adhesive paper and to then cut the pictures out and affix the adhesive to the page. The office takes official notice that adhesive backed paper in standard sizes that was could be photocopied and printed on by a computer was commonly commercially available to one of ordinary skill in the art at the time of the invention. One of ordinary skill in the art who was preparing a book, such as that for a child or for scrap booking, would know to combine Rifkin Engel and Smith in that they all deal with low technology preparation of such books. By combining Rifkin and Engel with Smith and the obvious printing to adhesive paper prior to affixing and laminating, the result would have been selection of creative matter to be disposed to a label, disposing such matter to the label and affixing at least a portion of that label or adhesive page to a page in a book, and then laminating the book page.

Regarding **dependent claim 4**, Rifkin in view of Engel in further view of Smith teaches:

The method of claim 3, wherein said protective covering matingly conforms at least to said adhesive label.

The lamination process is taught as discussed under the 35 U.S.C. 103 rejection claim 3 above. The claimed further limitation by use of an adhesive or heat set clear laminate to "matingly conform" would have been obvious to one of ordinary skill in the art. The office takes official notice that it that lamination of a book page may include use of clear adhesive laminates such as by clear plastic shelf liner, commercial laminates such as for scrapbook use, or other adhesive or heat set laminates, all of which laminates were commonly commercially to one of ordinary skill in the art at the time of the invention. Such choice of laminates over lamination by insertion in a plastic sheet protector or other laminate would be a mere design choice between equivalents known by one of ordinary skill in the art at the time of the invention. Additionally, Substitution of adhesive or heat-set lamination over lamination by insertion is a mere substitution of art recognized equivalents. Further, the office takes official notice that it was well known to one of ordinary skill in the art at the time of the invention that the use of thin adhesive and heat-set laminate sheets would result in a lamination that matingly conformed to anything affixed to a page.

Regarding **dependent claim 13**, Rifkin in view of Engel in further view of Smith teaches:

The system of claim 10, wherein said output device or said user disposes a clear

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protective covering over said adhesive label affixed to at least a portion of said page, wherein said at least a portion of said creative content disposed on said label is visible through said protective covering.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. See, Smith, page 1: "Enlarge the pictures and text, color them, glue them to construction paper, and laminate them to make a Big Book for Shared Reading . . ."

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. Although Smith does teach using adhesive stickers to affix the pictures to the book pages prior to lamination, it would have been obvious to one of ordinary skill in the art at the time of the invention to enlarge the pictures by photocopying or computer printing onto widely commercially available adhesive paper and to then cut the pictures out and affix the adhesive to the page. The office takes official notice that adhesive backed paper in standard sizes that was could be photocopied and printed on by a computer was commonly commercially available to one or ordinary skill in the art at the time of the invention. One of ordinary skill in the art who was preparing a book, such as that for a child or for scrap booking, would know to combine Rifkin Engel and Smith in that they all deal with low technology preparation of such books. By combining Rifkin and Engel with Smith and the obvious printing to adhesive paper prior to affixing and laminating, the result would have been selection of creative matter to be disposed to a label, disposing such matter to the label and affixing at least a portion of that label or

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adhesive page to a page in a book, and then laminating the book page.

Regarding **dependent claim 14**, Rifkin in view of Engel in further view of Smith:

The system of claim 13, wherein said protective covering matingly conforms to at least said adhesive label.

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. The lamination process is taught as discussed under the 35 U.S.C. 103 rejection claim 13 above. The claimed further limitation by use of an adhesive or heat set clear laminate to "matingly conform" would have been obvious to one of ordinary skill in the art. The office takes official notice that it that lamination of a book page may include use of clear adhesive laminates such as by clear plastic shelf liner, commercial laminates such as for scrapbook use, or other adhesive or heat set laminates, all of which laminates were commonly commercially to one of ordinary skill in the art at the time of the invention. Such choice of laminates over lamination by insertion in a plastic sheet protector or other laminate would be a mere design choice between equivalents known by one of ordinary skill in the art at the time of the invention. Additionally, Substitution of adhesive or heat-set lamination over lamination by insertion is a mere substitution of art recognized equivalents. Further, the office takes official notice that it was well known to one of ordinary skill in the art at the time of the invention that the use of thin adhesive and heat-set laminate sheets would result in a lamination that matingly conformed to anything affixed to a page.

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18. **Independent Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rifkin (U.S. Patent 6,116,906 [hereinafter "Rifkin"]), in view of Engel (U.S. Patent 4,714,275 [hereinafter "Engel"]), and further in view of Kalisher (U.S. Patent 5,524,932 [hereinafter "Kalisher"]), wherein Rifkin recites that it was well known in the art at the time of the Rifkin invention (filed in 1998) of printing user selected designs onto adhesive paper to be used like conventional stickers, and Engel recites that the it was well known in the art at the time of the Engel invention (filed in 1986) to mount stickers in albums in an order that tells a story.

Regarding **Independent claim 20**, Rifkin and Engel teach:

A system for publishing a book, said system comprising:

an input device for obtaining creative content for inclusion in said book;

(See, Rifkin, col. 1, lines 19-23: *"Desktop publishing may be obtained from a number of software providers which is used by the computer to create images at the user's selection upon the display monitor which are then passed to the printer for a hard copy of the selected design."*)

- a processor for controlling the disposing of at least a portion of a representation of said creative content on an adhesive label, a substance, a layout, and an extent of said at least a portion of said creative content disposed on said adhesive label being fully customizable;

(See, Rifkin, col. 1, lines 19-23, quoted above.)

- an output device for performing said disposing;

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(See, Rifkin, col. 1, lines 19-23, quoted above.)

- a book being a page for affixing said adhesive label with at least a portion of said representation of said creative content disposed thereon to at least a portion of said page, wherein said obtaining, said disposing, and said affixing are performed under the direct control of said user, and said book includes a fully personalized and completely customized story.

(See, Engel, col. 1, lines 16-17: "*A popular hobby with children is collecting theme stickers and mounting them in an album.*" See also Engel, col. 1, lines 23-35: "*It has been discovered that the present product provides the following entertaining features: purchasing packets of stickers which upon opening contain the surprise element of finding randomly assorted numbered stickers for a specific album, matching and mounting the numbered stickers to the corresponding numbered rectangular blank spaces within the album, trading excess duplicate stickers with other collectors in order to complete the albums, and finally reading the story line printed under each illustrated sticker throughout the album. When each collection is completed these albums provide a full color illustrated story book.*")

Rifkin teaches that it was known in the art to use of a computer and computer program for the selection of matter to be printed onto an adhesive label page and the use of a printer to produce such labels. Specifically, Rifkin teaches creating customizable stickers on a computer and printing them out and affixing the resulting label or sticker to a toy. Rifkin does not disclose that it was well known to place such stickers in a book.

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Engel teaches that affixing stickers to books was well known by those of ordinary skill in the art at the time of the invention. Further, Engel teaches that it was known by one of ordinary skill in the art at the time of the invention to organize stickers to tell a story. Engel does not teach obtaining creative content for those stickers from a computer and disposing that creative content onto stickers using the computer's printer, nor does Engel teach using the customized stickers tell a fully personalized and completely customized story.

In combination, the teachings of Engel and Rifkin would result in selection of creative material from a computer using software to manipulate such images, disposing that material to an adhesive label using a computer and attached printer, printing out the label, and affixing the label or sticker to a page of a book. The combination of the teachings of Engel and Rifkin would also result in the organization of the customized stickers to tell a story. It is common sense that any arrangement of customized stickers to tell a story will necessarily be fully personalized by the author. It is also common sense that a user would be capable of organizing such customized stickers into a story that is also completely customized.

One of ordinary skill in the art at the time of the invention facing the problem of creating stickers with a computer in order to place those stickers in a book would be motivated to combine Engel and Rifkin. Both Engel and Rifkin are related patents dealing with uses of adhesive labels relating to children and children's games and it would be obvious to one of ordinary skill in the art to combine the teachings of Rifkin to use a computer to print out stickers with the teachings of Engel recognizing that it was



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old in the art to place stickers in a book and to tell a story with those stickers. The resultant combination would be the selection of content from a program on the computer, creation of one or more stickers on the computer, printing out the stickers onto adhesive backed paper sheets, and placing the resultant stickers on one or more pages in a book to tell a personalized and customized story.

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure:

Low and High-Tech Strategies for Literacy, by Privratsky, Kathy, Special Education Service Agency, SESA Spring '99 Newsletter, published on the Internet on February 5, 2001 at [www.sesa.org/sesa/newsltr/ref\\_literacy/strateies.html](http://www.sesa.org/sesa/newsltr/ref_literacy/strateies.html), disclosing laminating book pages, last downloaded on 8/5/05.

Individuals associated with the filing or prosecution of a patent application are reminded of their obligations pursuant to 37 CFR 1.56. See generally, MPEP 2001 and subsections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday Thru Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB

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**PRIMARY EXAMINER**  
*8/15/2006*